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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,422	02/07/2002	Jian Ni	PT004P1C1	8521

22195 7590 06/30/2003

HUMAN GENOME SCIENCES INC
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EXAMINER

ANDRES, JANET L

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 06/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/067,422

Applicant(s)

NI ET AL.

Examiner

Janet L. Andres

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12,13,17-20 and 22-42 is/are pending in the application.
- 4a) Of the above claim(s) 12,13,17-20 and 22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-32 is/are allowed.
- 6) ☒ Claim(s) 33-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group II in Paper No. 4 is acknowledged.

Applicant argues that search and examination of all of the groups would not constitute an undue burden because search of one group would provide information useful for the search of another. Applicant further argues that MPEP § 803.04 states that up to ten sequences may be examined in a single application. Applicant concludes that all inventions should be examined.

Applicant's arguments have been fully considered but have not been found to be persuasive. As stated in the office action of paper no. 3, the different groups of nucleic acids, proteins, antibodies, and methods represent different inventions and require different, non-contiguous searches, as evidenced by their different classification. They require separate searches of separate databases. A search for nucleotide sequences that encode a protein yields no comparison of that protein to other proteins; such comparison requires a separate search that yields no comparison of one polynucleotide sequence to another. The search for antibodies is additionally separate because it requires identification of antibodies that could be cross-reactive and thus inherently anticipate the claimed invention. The search for methods of use is separate because it requires additional considerations as to the methodology itself. Thus to consider all of these groups would constitute an undue burden because each requires considerations that are separate from each of the others.

Applicant further argues that MPEP § 803.04 provides for the search of up to ten sequences, pointing to the O.G. notice of 1996. MPEP § 803.04 does not require that ten sequences be examined; given the ever-increasing size of the databases, search and consideration

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of more than a single sequence constitutes an undue search burden on the office. Each individual sequence represents a structurally and functionally distinct entity that must be searched separately. Additionally, it is noted that, in the instant application, the claimed inventions include polynucleotides that are not linked either by structure or function. These inventions clearly require separate searches of the art that are independent of and in addition to the sequence searches.

Applicant's remarks in reference to the fact that the elected invention includes polynucleotides encoding SEQ ID NO: 10 are noted. That is the search that was performed.

Applicant additionally states that if the elected claims are found allowable, process claims may be rejoined, citing MPEP § 821.04. Rejoinder does not, however, affect restriction practice, as is indicated in the first line of MPEP § 821.04.

The requirement is still deemed proper and is therefore made FINAL. Claims 12, 13, 17-20, and 22-42 are pending in this application. Claims 12, 13, 17-20, and 22 are withdrawn from consideration as being drawn to a non-elected invention.

Specification

2. The title of the invention is not descriptive. What is claimed is not a BMP, but a lysyl oxidase. A new title is required that is clearly indicative of the invention to which the claims are directed.
3. The use of the trademark QIAGEN (p. 40) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

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Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 33-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicants' referral to the deposit of HOHEC84 on page 25 of the specification and in claim 33 is an insufficient assurance that all of the conditions of 37 CFR sections 1.801 through 1.809 have been met. If the deposits were made under the provisions of the Budapest Treaty, filing of an affidavit or declaration by applicants, assignees or a statement by an attorney of record over his or her signature and registration number stating that the deposits have been accepted by an International Depository Authority under the provisions of the Budapest Treaty, that all restrictions upon public access to the deposits will be irrevocably removed upon the grant of a patent on this application and that the deposit will be replaced if viable samples cannot be dispensed by the depository is required. This requirement is necessary when deposits are made under the provisions of the Budapest Treaty as the Treaty leaves these specific matters to the discretion of each State. Additionally, amendment of the specification to recite the date of the

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deposit, the complete name and address of the depository, and the accession number of the deposited cell line is required.

CLAIMS 33-42 ARE REJECTED. CLAIMS 23-32 ARE ALLOWED.

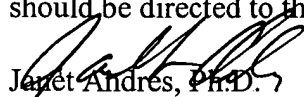
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet Andres, Ph.D., whose telephone number is (703) 305-0557. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564. The fax phone number for this group is (703) 872-9306 or (703) 872-9307 for after final communications.

Communications via internet mail regarding this application, other than those under U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to yvonne.eyler@uspto.gov.

All Internet email communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


Janet Andres, Ph.D.
Patent Examiner
June 27, 2003